

REMARKS

The Office Communication alleged that Applicants' Request for Reconsideration filed January 16, 2004, was not fully responsive to the Office Action of September 23, 2003. Specifically, the Office Communication stated that in the previous Office Action Applicants were asked whether SHERLOCK® or PIRANHA® were known and/or available to Applicants at the time of the invention and that the Applicants have not answered this question. The Communication further stated that the Applicants replied in the Request for Reconsideration that the SHERLOCK® and PIRANHA® references were improper but that the Applicants did not state why they are improper references.

Applicants acknowledge that machine vision software and cameras, such as SHERLOCK® and PIRANHA®, existed independently without modification in their respective fields of art and as such were known to Applicants during preparation of the present application. Applicants do not admit, however, that it would have been obvious to use such machine vision software and cameras in a process for monitoring web formation. In contrast, Applicants adapted and combined such machine vision software and cameras with other inventive elements to achieve the present invention. Applicants accordingly provided SHERLOCK® and PIRANHA® as best mode examples in the present application when it was filed on January 29, 2001.

To clarify Applicants' position regarding SHERLOCK® and PIRANHA® as improper references, Applicants are not claiming an invention in either machine vision software or cameras alone. Applicants are claiming an inventive combination of these and other elements. Applicants respectfully submit that the claimed combination was not used in the field of analyzing web formation as evidenced by the failure of the Office

to show prior art disclosing the claimed combination. Thus, the Office has not made a *prima facie* case of obviousness since all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180, U.S.P.Q. 580 (CCPA 1974).

Further, to establish *prima facie* obviousness of a claimed invention, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. MPEP, pages 700-31 (8th ed., Aug. 2001).

Applicants respectfully submit that the Office has not shown teachings in the references cited by the Office to motivate one skilled in the art to combine the references with the SHERLOCK® and PIRANHA® best mode examples to render the present invention obvious. Merely combining elements found in the numerous prior art references cited by the Office with Applicants' best mode examples would employ impermissible hindsight afforded by Applicants' own application.

Applicants incorporate by reference Applicants' Request for Reconsideration dated January 16, 2004, and respectfully submit that in conjunction with the present Supplemental Response, Applicants have fully responded to the Office Communication of April 5, 2004.

Applicants respectfully submit that the present invention is patentable over the cited references and Applicants respectfully request withdrawal of the rejections and allowance of all pending Claims 1-27.


If the Examiner has any questions upon consideration of this Supplemental Response, Applicants invite the Examiner to contact the undersigned at his convenience.

Please charge any additional fees required by this Supplemental Response to
Deposit Account No. 04-1403.

Respectfully submitted,

DORITY & MANNING, P.A.

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Date


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